UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,020	07/31/2003	Carl Smith	VISAP076	4731

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EXAMINER
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SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 January 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is issued in response to applicant filed request for continued

examination (RCE) on 01/08/2007.

2.   No claims have been amended. No claims were added. No claims were

canceled.

3.   Claims 1 – 20 are pending in this application.

4.   Applicant's arguments with respect to claim 1 – 20 have been considered but are

moot in view of the new ground(s) of rejection.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

10/11/2006 has been entered.

7.105 Requirement for Information

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

Examiner requests a clarification whether this invention was reduced to practice on year prior to the filing data of the instant application? If yes please provide any related documents pertained to the claimed invention.

In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with

candor and good faith under 37 CFR 1.56. Where the applicant does not have or

cannot readily obtain an item of required information, a statement that the item is

unknown or cannot be readily obtained may be accepted as a complete reply to the

requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete

reply to the enclosed Office action must include a complete reply to this requirement.

The time period for reply to this requirement coincides with the time period for reply to

the enclosed Office action.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

7.   Claim 1 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Tushie et al. (Tushie hereinafter) (US Patent No. 6,014,748) in view of Harms et al.

(Harms hereinafter) (US Patent No. 6,070,147).

Regarding Claim 1, Tushie discloses a method for automating the

personalization of a batch of smart cards (Col. 5 and 6, lines 66 – 67 and 1 – 5, Tushie),

comprising:

executing a personalization assistant tool (Col. 2, lines 38 – 40, Tushie), said

software tool including a default member profile having default values for smart card

features (Col. 2 and 18, lines 39 – 40 and 11 – 24, Card Framework Template Record,

Tushie[1]);

Furthermore, Tushie also discloses a method and system for receiving smart

card feature information (Page 6, lines 40 – 46, Tushie) that was previously entered into

a cardholder database management system by a user (Fig. 1B, item 152, Page 7, lines

48 – 59, Tushie). In addition, Tushie discloses that the smart card personalization

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[1] Specifically, wherein features, such as, security architecture (Col. 9, lines 59 – 67, Tushie), secure key
data authentication, data integrity, data secrecy (Col. 10, lines 20 – 24, Tushie), digital signature
mechanisms (Col. 10, lines 24 – 27, Tushie), and encrypting the transmitted data with a private key (Col.

system will create smart cards according to the information received from alternate

inputs (Col. 6, lines 54 – 56, Tushie) and from a software tool (Fig. 1A, item 150, Card

Issuer Mgnt System, Page 9, lines 23 – 26 and 33 – 38; respectively, Tushie). However,

Tushie is silent with respect to the details on how the user enters such smart card

information into the system. On the other hand, Harms discloses computer instructions

for providing a user with a plurality of queries regarding said smart card features (Col. 5,

lines 17 – 24, Harms), said queries originating from said software tool (Col. 5, lines 1 –

5; " ...the identification terminal 15 could be integrated into a single reader...", Harms);

receiving from the user responses to the plurality of queries, said responses being

received by said software tool (Col. 5, lines 17 – 24 and 49 – 51, "... the identification

information gathered by the identification terminal 15...", Harms); matching each of said

responses with an output data value, said matching being performed by said software

tool (Col. 9, lines 41 – 46; Harms); modifying said default member profile using said

matched output data values (Col. 9, lines 44 – 50, Harms); generating a personalization

data file from said default member profile and said output data values (Col. 9, lines 61 –

67, Harms), wherein the output data values of said personalization data file are used to

provide said smart card features on said batch of smart card when said batch of smart

cards is personalized (Col. 5, lines 41 – 47, Harms). It would have been obvious to one

of ordinary skill in the art at the time the invention was made to incorporate the

teachings of Harms as a method for users to enter personalized information in the

Tushie system at Fig. 1B, item 152, Card Holder Data, to the smart card personalization

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10, lines 27 – 30, Tushie) corresponds to the smart cards features that are high-level smart card

system of Tushie. Skilled artisan would have been motivated to do so, as suggested by

Harms (Col. 3, lines 44 – 45, Harms), to provide a customer-friendly and sustainable

approach. In addition, both of the references (Tushie **and** Harms) teach features that

are directed to analogous art and they are directed to the same field of endeavor, such

as, databases management systems, **smart cards, and smart card input**

information. This close relation between both of the references highly suggests an

expectation of success.

Regarding Claim 2, the Tushie in view of Harms combination discloses a method,

further comprising using individual cardholder input files and the personalization data

file to personalize a plurality of smart cards to yield a plurality of personalized smart

cards (Col. 2, lines 46 – 54, Tushie; and Col. 4, and 5, lines 47 – 54 and 49 – 51;

respectively, Harms).

Regarding Claim 3, the Tushie in view of Harms combination discloses a method,

wherein the generating a personalization data file, comprises:

providing a look up table with entries for various combinations of responses to

the plurality of queries (Fig. 5, Col. 9, lines 36 – 41, Harms);

finding a matching entry in the look up table that matches the responses to the

plurality of queries (Fig. 5, Col. 9, lines 41 – 45, Harms);

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management instructions as claimed.

locating personalization data file output associated with the matching entry (Fig.

5, Col. 9, lines 41 – 45, Harms); and

outputting the personalization data file output associated with the matching entry

(Col. 11, lines 50 – 55, Harms).

Regarding Claim 4, the Tushie in view of Harms combination discloses a method,

wherein the plurality of queries, comprise:

at least one query regarding smart card account usage control (Col. 5, lines 19 –

24, Harms);

at least one query regarding smart card account risk management (Col. 5, lines

19 – 24, Harms); and

at least one query regarding offline limits and thresholds (Col. 5, lines 19 – 24,

Harms).

Regarding Claim 5, the Tushie in view of Harms combination discloses a method,

wherein responses to the plurality of queries are used to provide best practices

recommendations (Col. 11, lines 45 – 50, Harms).

Regarding Claim 6, the Tushie in view of Harms combination discloses a method,

further comprising providing regional profiles and subregional profiles, wherein a

subregion is within a region, wherein the regional and subregional profiles have

mandatory and recommended settings, wherein some of the subregional profiles are

more stringent than regional profiles in which the subregions belong (Col. 7, lines 14 –

21 and 58 – 63, Harms).

        Regarding Claim 7, the Tushie in view of Harms combination discloses a method,

wherein the generating a personalization data file, comprises:

        providing a look up table with entries for various combinations of responses to

the plurality of queries (Fig. 5, Col. 9, lines 36 – 41, Harms);

        finding a matching entry in the look up table that matches the responses to the

plurality of queries (Fig. 5, Col. 9, lines 41 – 45, Harms);

        locating personalization data file output associated with the matching entry (Fig.

5, Col. 9, lines 41 – 45, Harms); and

        outputting the personalization data file output associated with the matching entry

(Col. 11, lines 50 – 55, Harms).

        Regarding Claim 8, the Tushie in view of Harms combination discloses a method,

wherein the plurality of queries, comprise:

        at least one query regarding smart card account usage control (Col. 5, lines 19 –

24, Harms);

        at least one query regarding smart card account risk management (Col. 5, lines

19 – 24, Harms); and

        at least one query regarding offline limits and thresholds (Col. 5, lines 19 – 24,

Harms).

Regarding Claim 9, the Tushie in view of Harms combination discloses a

method, further comprising computer instructions for using responses to the plurality of

queries to provide best practices recommendations (Col. 11, lines 45 – 50, Harms).

Regarding Claim 10, the Tushie in view of Harms combination discloses a

method, further comprising providing regional profiles and subregional profiles, wherein

a subregion is within a region, wherein the regional and subregional profiles have

mandatoryand recommended settings, wherein some of the subregional profiles are

more stringent than regional profiles in which the subregions belong (Col. 7, lines 14 –

21 and 58 – 63, Harms).

Regarding Claim 11, the Tushie in view of Harms combination discloses a

computer implemented method for automating the personalization of a batch of smart

cards (Col. 5 and 6, lines 66 – 67 and 1 – 5, Tushie), comprising:

running on a host computer a personalization assistant software application (Col.

2 and 6, lines 38 – 40 and 57 – 58; respectively, Tushie), said software application

including a default member profile having default values for smart card features (Col. 2

and 18, lines 39 – 40 and 11 – 24, Card Framework Template Record, Tushie[2]);

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[2] Specifically, wherein features, such as, security architecture (Col. 9, lines 59 – 67, Tushie), secure key
data authentication, data integrity, data secrecy (Col. 10, lines 20 – 24, Tushie), digital signature
mechanisms (Col. 10, lines 24 – 27, Tushie), and encrypting the transmitted data with a private key (Col.
10, lines 27 – 30, Tushie) corresponds to the smart cards features that are high-level smart card
management instructions as claimed.

providing to at least one user system over a network a plurality of queries

regarding smart card features (Col. 5, lines 17 – 24, Harms), said queries originating

from said software application (Col. 5, lines 1 – 5; " ...the identification terminal 15 could

be integrated into a single reader...", Harms);

receiving from the at least one user system over the network responses to the

plurality of queries, said responses being received by said software application tool

(Col. 5, lines 17 – 24 and 49 – 51, "... the identification information gathered by the

identification terminal 15...", Harms);

matching each of said responses with an output data value, said matching being

performed by said software tool (Col. 9, lines 41 – 46; Harms);

modifying said default member profile using said matched output data values

(Col. 9, lines 44 – 50, Harms);

generating a personalization data file from said default member profile and said

output data values (Col. 9, lines 61 – 67, Harms), wherein the output data values of said

personalization data file are used to provide said smart card features on said batch of

smart card when said batch of smart cards is personalized (Col. 9, lines 33 – 38,

Tushie; and Col. 5, lines 41 – 47, Harms).

Regarding Claim 12, the Tushie in view of Harms combination discloses a

computer implemented method, further comprising:

sending the personalization data file to a preparation processing device (Fig. 1A,

item 100 and 150, Col. 6, lines 42 – 46, Tushie; and Col. 6, lines 32 – 35, Harms);

and

using the personalization data file and cardholder input files to personalize smart

cards (Fig. 1A, items 130 and 160, Col. 6, lines 45 – 47, Tushie).

Regarding Claim 13, the Tushie in view of Harms combination discloses a

computer implemented method, wherein the generating a personalization data file,

comprises:

providing a look up table with entries for various combinations of responses to

the plurality of queries (Fig. 5, Col. 9, lines 36 – 41, Harms);

finding a matching entry in the look up table that matches the responses to the

plurality of queries (Fig. 5, Col. 9, lines 41 – 45, Harms);

locating personalization data file output associated with the matching entry (Fig.

5, Col. 9, lines 41 – 45, Harms); and

outputting the personalization data file output associated to the matching entry

(Col. 11, lines 50 – 55, Harms).

Regarding Claim 14, the Tushie in view of Harms combination discloses a

computer implemented method, wherein the plurality of queries, comprise:

at least one query regarding smart card account usage control (Col. 5, lines 19 –

24, Harms);

at least one query regarding smart card account risk management (Col. 5, lines

19 – 24, Harms); and

at least one query regarding offline limits and thresholds (Col. 5, lines 19 – 24,

Harms).

Regarding Claim 15, the Tushie in view of Harms combination discloses a

computer implemented method, wherein responses to the plurality of queries are used

to provide best practices recommendations (Col. 11, lines 45 – 50, Harms).

Regarding Claim 16, the Tushie in view of Harms combination discloses a

computer implemented method, further comprising providing regional profiles and

subregional profiles, wherein a subregion is within a region, wherein the regional and

subregional profiles have mandatory and recommended settings, wherein some of the

subregional profiles are more stringent than regional profiles in which the subregions

belong (Col. 7, lines 14 – 21 and 58 – 63, Harms).

Regarding Claim 17, the Tushie in view of Harms combination discloses a

computer implemented method, wherein the generating a personalization data file,

comprises:

providing a look up table with entries for various combinations of responses to

the plurality of queries (Fig. 5, Col. 9, lines 36 – 41, Harms);

finding a matching entry in the look up table that matches the responses to the

plurality of queries (Fig. 5, Col. 9, lines 41 – 45, Harms);

locating personalization data file output associated with the matching entry (Fig.

5, Col. 9, lines 41 – 45, Harms);

and

outputting the personalization data file output associated to the matching entry

(Col. 11, lines 50 – 55, Harms).

Regarding Claim 18, the Tushie in view of Harms combination discloses a

computer implemented method, wherein the plurality of queries, comprise:

at least one query regarding smart card account usage control (Col. 5, lines 19 –

24, Harms);

at least one query regarding smart card account risk management (Col. 5, lines

19 – 24, Harms); and

at least one query regarding offline limits and thresholds (Col. 5, lines 19 – 24,

Harms).

Regarding Claim 19, the Tushie in view of Harms combination discloses a

computer implemented method, wherein responses to the plurality of queries are used

to provide best practices recommendations (Col. 11, lines 45 – 50, Harms).

Regarding Claim 20, the Tushie in view of Harms combination discloses a

computer implemented method, further comprising providing regional profiles and

subregional profiles, wherein a subregion is within a region, wherein the regional and

subregional profiles have mandatory and recommended settings, wherein some of the

subregional profiles are more stringent than regional profiles in which the subregions

belong (Col. 7, lines 14 – 21 and 58 – 63, Harms).

Prior Art Made Of Record

1.   Tushie et al. (US Patent No. 6,014,748) discloses a system and apparatus for

smart card personalization.

2.   Tommy J. Morris (US Patent Pub. Application No. 2004/0078227 A1) discloses a

system and method for handling medical information.

3.   Tommy J. Morris (Provisional US App. No. 60/381,058).

4.   Harms et al. (Harms hereinafter) (US Patent No. 6,070,147).

5.   Hamann et al. (US Patent No. 6,729,549 B2) discloses a system and method for

personalization of smart cards.

6.   Handel et al. (US Patent N. 6,195,651 B1) discloses a system, method and

article of manufacture for a tuned user application experience.

7.   Bessette (US Patent No. 6,263,330 B1) discloses a method and apparatus for

the management of data files.

8.   Ballantyne et al. (US Patent No. 5,867,821) discloses a method and apparatus

for electronically accessing and distributing personal health care information and

services in hospitals and homes.

9.   Non- Patent Literature: "A Web-Enabled FRAMEWORK for SMART CARD

Application in Health Services"; Alvin T.S. Chan, Jiannong Cao, Henry Chan, and

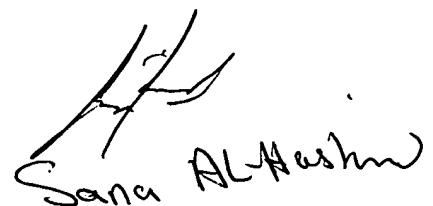Gilbert Young; September 2001 ACM.

Points Of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna Colan whose telephone number is (571) 272-2752. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Giovanna Colan
Examiner
Art Unit 2162
March 22, 2007